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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/307,195	05/07/1999	WILLIAM COHN	BIH97-04A2	4520
30407	7590	06/29/2004	EXAMINER	
BOWDITCH & DEWEY, LLP 161 WORCESTER ROAD P.O. BOX 9320 FRAMINGHAM, MA 01701-9320			SMITH, JEFFREY A	
			ART UNIT	PAPER NUMBER
			3625	

DATE MAILED: 06/29/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/307,195

Applicant(s)

COHN, WILLIAM

Examiner

Jeffrey A. Smith

Art Unit

3625

*MLW*

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 March 0204.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 18-24 is/are allowed.
- 6) ☒ Claim(s) 1-14, 16, 17, 25-36 and 41-50 is/are rejected.
- 7) ☒ Claim(s) 15 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 07 May 1999 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

Art Unit: 3625

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114 was filed in this application after appeal to the Board of Patent Appeals and Interferences, but prior to a decision on the appeal. Since this application is eligible for continued examination under 37 CFR 1.114 and the fee set forth in 37 CFR 1.17(e) has been timely paid, the appeal has been withdrawn pursuant to 37 CFR 1.114 and prosecution in this application has been reopened pursuant to 37 CFR 1.114. Applicant's submission filed on 10 March 2004 has been entered.

***Response to Amendment***

The response deposited 10 March 2004 to the Office Action mailed 08 April 2003 has been entered.

Claims 1, 25, 27, 28, 32, 34, 41 have been amended by such response. Claims 1-50 remain pending and an action on the merits of such claims follows.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

Art Unit: 3625

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 1-3, 5-10, 12-14, 16, 25-27, 29-34, 36, 41, 42, and 44-49 are rejected under 35 U.S.C. 102(e) as being anticipated by Benetti et al. (U.S. Patent No. 5,894,843).

Benetti et al. discloses (Fig. 7) a surgical device (60) comprising a retaining element/base (62) having an aperture (61); a flexible cord connector ("suture line": col. 12, line 27); a plurality of holders (70); a handle (69); and a tab (63).

#### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Art Unit: 3625

Claims 4, 11, 17, 28, 35, 43, and 50 are rejected under 35 U.S.C. 103(a) as being unpatentable over Benetti et al. (U.S. Patent No. 5,894,843).

Although Benetti et al. does not disclose irrigation or suction, it would have been obvious to one of ordinary skill in the art to have provided the device reported above to have included such structure because the use of irrigation and suction are well-known for use during surgeries of the type disclosed by Benetti et al.

***Allowable Subject Matter***

Claim 15 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 18-24, and 37-40 are allowed.

***Response to Arguments***

Applicant's arguments deposited 10 March 2004 have been fully considered but they are not persuasive.

Applicant maintains: "the prior art structure is not capable of performing the intended use [of the instant invention]".

Art Unit: 3625

The Examiner maintains that the device (or retractor) disclosed by Benetti is reasonably capable of performing the recited functions. In weighing the language of the apparatus claims, the Examiner has adhered to the guidance provided by the Courts in *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963).

Benetti et al. '843 is replete with reference to devices (or retractors) comprising a holder on a retaining element (or base) that holds a connector (i.e. a suture line) that positions the connector to compress the cardiac tissue of the operative site against a retaining element surface. Although Benetti et al. does not expound upon port 70 in their description of the embodiment of Fig. 7, they do refer to such port's utility (i.e. "for receiving a suture line" (col. 12, lines 26-27)). Benetti et al. details the full utility of such suture line receiving port in reference to previous embodiments (see col. 10, lines 57-62; col. 11, lines 19-30; col. 11, line 60-col. 12, line 4). Benetti et al. further teaches that "[i]n some embodiments, as described herein, the contact members 1 may have apertures, openings or attachments to facilitate connection with sutures or other devices to achieve the requisite stabilization" (col. 7, lines 20-24).

Art Unit: 3625

Applicant argues that embodiments of Figures 5 and 6 "do not disclose or suggest the structural relationship that the flexible cord is held by the holder such tha the artery is compressed between the cord an dthe holder".

The Examiner has not relied upon the embodiments of Figure 5 or 6 to disclose or suggest the structural relationship that the flexible cord is held by the holder such that the artery is compressed between the cord and the holder, per se. Rather, the Examiner has relied upon the entirety of the single Benetti et al. disclosure in anticipation of Applicant's claims because the disclosure reasonably teaches the full capability of the ports 70 as for receiving a suture line for administering the requisite stabilization of the operative site (e.g. cardiac tissue (col. 11, line 67-col. 12, line 4)) and for depressing the tissue adjacent the target artery (col. 11, lines 27-30).

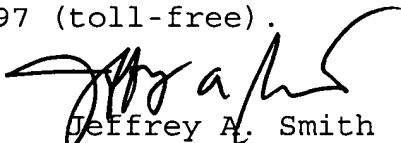
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Smith whose telephone number is 703-308-3588. The examiner can normally be reached on M-F 6:30am-6:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Wynn Coggins can be reached on 703-308-1344. The fax phone number for the

Art Unit: 3625

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

  
Jeffrey A. Smith  
Primary Examiner  
Art Unit 3625

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